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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,759	01/17/2002	Atsushi Watanabe	100353-00093	2648

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ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
Suite 600
1050 Connecticut Avenue, N.W.
Washington, DC 20036-5339

EXAMINER

CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/046,759	Applicant(s) WATANABE ET AL.	
	Examiner David G. Cervetti	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed February 24, 2006, have been fully considered.
2. Claims 1-10 are pending and have been examined.

Response to Amendment

3. Examiner respectfully submits that Guthery discloses a semiconductor integrated circuit including a decoder circuit (column 5, lines 15-45) which makes each of a plurality of hardware function blocks (column 7, lines 22-33, claims 1-24, authentication table holds a list of authenticatable entities, people, agencies, codes, hardware, and so on) separately either usable or unusable depending on the decoded license information. Regarding Applicant's argument that Guthery does not suggest or disclose making each of a plurality of hardware function blocks separately either usable or unusable, Examiner points Applicant's attention to "Instantaneous Authentication Command" section (column 11-12) where it is disclosed authenticating and enabling / disabling (making usable/ unusable).

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Claim Objections

5. Claim 10 is objected to because of the following informalities: "LSI" must be spelled out. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Pages 1-3 of the specification appear to disclose hardware to decide whether to allow use of function blocks subject to intellectual property rights, nowhere it is specified that such function blocks are hardware. The function block as it relates to the application (pages 1-3), appears to be software (function) not hardware.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Guthery (US Patent 6,567,915).

Regarding claim 1, Guthery teaches a semiconductor integrated circuit (abstract), comprising: a plurality of hardware function blocks (column 7, lines 1-67); a nonvolatile memory unit which stores therein coded license information indicative of a usable/unusable status separately for each of the plurality of hardware function blocks (column 7, lines 1-67, column 8, lines 1-67); and a decoder circuit which decodes the license information stored in said nonvolatile memory unit, and makes each of the hardware function blocks separately either usable or unusable depending on the decoded license information (column 10, lines 1-67, column 11, lines 1-67).

Regarding claim 2, Guthery teaches a status unit that has at least part of the decoded license information stored therein in such a manner as to be accessible from an exterior of said semiconductor integrated circuit (column 6, lines 40-67, column 7, lines 1-55).

Regarding claim 3, Guthery teaches a calendar circuit which indicates a current date and time, wherein said decoder circuit makes said plurality of hardware function blocks usable in response to a finding that the current date and time indicated by the calendar circuit is within a valid period indicated by the decoded license information, and makes said plurality of hardware function blocks unusable in response to a finding that the current date and time indicated by the calendar circuit is after a valid period indicated by the decoded license information (column 12, lines 40-60).

Regarding claim 4, Guthery teaches a counter circuit that counts a number indicative of how many times said plurality of hardware function blocks are used, wherein said decoder circuit makes said plurality of hardware function blocks usable in response to a finding that the number counted by said counter circuit is within a number of valid use indicated by the decoded license information, and makes said plurality of hardware function blocks unusable in response to a finding that the number counted by said counter circuit exceeds the number of valid use indicated by the decoded license information (column 10, lines 55-65).

Regarding claim 5, Guthery teaches a license encoder circuit which encodes the number counted by said counter circuit, wherein the number encoded by said

Art Unit: 2136

license encoder circuit is stored in said nonvolatile memory unit as updated license information (column 3, lines 1-67, column 10, lines 1-67, column 11, lines 1-67).

Regarding claim 6, Guthery teaches wherein coding and decoding of the license information is encrypting and decrypting that prevent the license information in said nonvolatile memory unit from being illegally rewritten (column 6, lines 1-67, column 7, lines 1-55).

Regarding claim 7, Guthery teaches a decoder which decodes the license information stored in said nonvolatile memory unit (column 6, lines 1-67); a license register which stores therein the decoded license information decoded by said decoder (column 6, lines 50-67, the private storage area); and a control circuit which makes said plurality of hardware function blocks either usable or unusable depending on the information stored in said license register (column 5, lines 40-67, column 6, lines 50-67).

Regarding claim 8, Guthery teaches wherein said control circuit controls a chip enable signal of said plurality of hardware function blocks in order to make said plurality of hardware function blocks either usable or unusable (column 5, lines 40-67, column 6, lines 50-67).

Regarding claim 9, Guthery teaches wherein said control circuit controls a clock signal of said plurality of hardware function blocks in order to make said plurality of hardware function blocks either usable or unusable (column 5, lines 1-67, column 6, lines 50-67).

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guthery, and further in view of Iguchi (US Patent Number: 6,198,669).

Regarding claim 10, Guthery does not expressly disclose receiving the coded license information from an external LSI tester, and no external pin is provided for a purpose of receiving the coded license information, but suggests using identifications signed by a manufacturer (columns 5-6). However, Iguchi teaches nonvolatile memory receiving information from an external LSI tester (column 1, lines 10-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the coded license information from an external LSI tester, and no external pin is provided for a purpose of receiving the coded license information. One of ordinary skill in the art would have been motivated to do so to avoid tampering the data already written to the device (Iguchi, column 2, lines 10-67).

Art Unit: 2136

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DGC

CHRISTOPHER REVAK
PRIMARY EXAMINER

CEL 5/9/06